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09/120,970

07/22/1998

ROY CURTISS III

53116-1763

2800

70953 7590 02/13/2009

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EXAMINER

PORTNER, VIRGINIA ALLEN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY CURTISS III
and
STEVEN A. TINGE

Application 09/120,970
Technology Center 1600

Mailed: February 13, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on August 12, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

37 CFR § 41.37(c) (v) (2006) reads as follows:

(v) *Summary Of Claimed Subject Matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 5 and 6 of the Appeal Brief filed January 23, 2007 is deficient because it does not separately map independent claim 30 to the specification. Correction is required.¹

APPEAL BRIEF, GROUNDS OF REJECTION

Section 1205.02(c)(1)(vi) of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) reads as follows:

(vi) *Grounds of rejection to be reviewed on appeal*.
A concise statement of each ground of rejection
presented for review.

¹ This deficiency was previously noted on page 2 of the Examiner’s Answer mailed August 6, 2007 and repeated on page 2 of the Examiner’s Answer mailed October 3, 2007.

The “Grounds of rejection to be reviewed on appeal” appearing on page 6 of the Appeal Brief is deficient because it does not include a listing of the claims involved in the rejections. Correction is required.

APPEAL BRIEF, ARGUMENTS

A review of the file also finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed January 23, 2007 under the heading “Argument” has not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellants have not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 5, August 2006) for details.

APPEAL BRIEF, CLAIMS APPENDIX

It is noted while claim 34 is listed on page 20 of the Claims appendix as being cancelled, it is listed on pages 1, 4 and 18 as being rejected. Clarification regarding the status of claim 34 is required.

EXAMINER'S ANSWER
GROUND OF REJECTION TO BE REVIEWED UPON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed October 3, 2007 under the heading "Grounds of rejection to be Reviewed on Appeal" is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief and/or the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the brief. Specifically, the Examiner's Answer fails to address the rejection of claims 41-49 and 65. While the Examiner has included claim 52 in the double patenting rejection, it should be noted that claim 52 was cancelled pursuant to the Amendment filed June 10, 2005.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

1) to hold the Appeal Brief filed December 13, 2007 defective, as required by 37 CFR § 41.37(d);

2) to notify Appellants to submit a revised Appeal Brief which corrects the “Summary of claimed subject matter,” “Grounds of rejection to be reviewed on appeal,” “Arguments” and if appropriate, the “Status of Claims” and “Conclusion”;

3) for clarification regarding the status of claim 34;

4) to acknowledge and consider the revised Appeal Brief;

5) to vacate the Examiner’s Answer mailed October 3, 2007;

6) to generate a new Examiner’s Answer setting forth the correct Grounds of rejection to be reviewed on appeal and to correct other sections of the Answer as may be required;

7) if appropriate, to include the approval of the Technology Center (TC) Director or his/her designee² (as required for any new grounds of rejection); and

8) for such further action as may be required.

PSB

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² In TC 1600, only the Director may approve new grounds of rejection.